UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/092,296 | 03/07/2002 | Akihiro Denda | Q68841 | 2668 |

23373 7590 05/05/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

| EXAMINER | |
|---|---|
| AGUSTIN, PETER VINCENT | |
| **ART UNIT** | **PAPER NUMBER** |
| 2652 | |

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/092,296 | DENDA ET AL. | |
| | Examiner | Art Unit | |
| | Peter Vincent Agustin | 2652 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-3* is/are allowed.

6)☒ Claim(s) *4-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 May 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1. Replacement drawings for Figures 1 & 3 were received on February 14, 2005. These drawings are acceptable.

2. The drawings filed May 10, 2002 are objected to because on Figure 2A, "PROGROAM" should be --PROGRAM--.

### *Claim Objections*

3. Claim 10 is objected to because of the following informalities:

Claim 10, line 9: "onto on" should be --onto--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 10, lines 8-9 recite "a controller which judges, prior to the first reproducer's reproduction of the program information, that the program information is copied onto on the second recording medium". This constitutes new matter. The Applicant's specification discloses a controller for judging that program information is copied onto a second recording medium, but

the Applicant's specification does not disclose that this judging step occurs "prior to the first reproducer's reproduction of the program information". As an example, the method of claim 4 clearly shows that the judging step is performed a few steps after the first reproducing step.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, lines 10-13 recite that the controller controls the first reproducer "to reproduce the program information being copied when it is judged that the program information is not copied onto the second recording medium". The limitation "the program information" on line 12 is described as not being copied onto the second recording medium; while the limitation "the program information" on lines 10-11 and the limitation "the program information" on lines 11-12 are described as being copied onto the second recording medium. Therefore, claim 10 is inconsistent, indefinite and misdescriptive of what is being claimed.

### *Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 4, 5 & 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US 6,292,440).

In regard to claim 4, Lee discloses an information reproducing method (inherent from the apparatus of Figure 1) comprising: reproducing program information (MP3 Audio File) recorded on a first recording medium (CD/CD-ROM; see 100); temporarily copying the reproduced program information on a second recording medium (200; column 3, lines 24-25); reproducing the copied program information (500); judging that the program information is copied onto the second recording medium when the program information recorded on the first recording medium is reproduced (inherent: note that the program information is either copied onto the second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. The file type detector 100 involves receiving source data and detecting the type of data, i.e., the "program information is reproduced" in order to detect the type of data. See column 3, lines 38-43); and controlling reproducing of the program information recorded on the first recording medium to be stopped and the copied program information to be reproduced if it is judged that the program information is copied (inherent: note that in the case where an ordinary audio CD file is detected (column 3, lines 50-55), data is reproduced directly; and in the case where an MP3 audio file is detected (column 3, lines 56-59), the program information copied in the second recording medium 200 is reproduced by element 500, thus, element 100 does not directly reproduce the audio signal, i.e., it is stopped).

In regard to claim 5, Lee discloses an information reproducing apparatus (Figure 1) comprising: a first reproducer (100) for reproducing program information (MP3 Audio File)

recorded on a first recording medium (CD/CD-ROM); a driver (inherent from column 3, lines 24-25: the claimed "driver" would be the inherent element that enables memory block 203 to receive the MP3 audio files) for temporarily copying on a second recording medium (200) the program information reproduced by the first reproducer; a second reproducer (500) for reproducing the program information on the second recording medium; and a controller which judges that the driver copied the program information to be reproduced onto the second recording medium (inherent: note that the program information is either copied onto the second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. The file type detector 100 involves receiving source data and detecting the type of data, i.e., the "program information is reproduced" in order to detect the type of data. See column 3, lines 38-43), wherein the controller controls the first reproducer not to reproduce the program information on the first recording medium and the second reproducer to reproduce the program information on the second recording medium if the second recording medium contains the program information (inherent: note that in the case where an ordinary audio CD file is detected (column 3, lines 50-55), data is reproduced directly; and in the case where an MP3 audio file is detected (column 3, lines 56-59), the program information copied in the second recording medium 200 is reproduced by element 500, thus, element 100 does not directly reproduce the audio signal, i.e., it is stopped).

In regard to claim 7, Lee inherently suggests that the controller controls the second reproducer not to reproduce the program information when the first recording medium is not mounted into the first reproducer. It should be noted that the claimed "program information" is

copied from the first recording medium. Therefore, when the first recording medium is not mounted, no program information is copied, and the second reproducing means would have nothing to reproduce, i.e., the control means automatically controls the second reproducing means not to reproduce in the absence of the first recording medium. In this case, when the CD/CD-ROM of figure 1 is not mounted, the file type detector 100 would not detect an MP3 Audio File or an Ordinary Audio CD File, and the MP3 Decoder 500 would have nothing to reproduce.

In regard to claim 8, Lee discloses that the first reproducer is a CD player (abstract, line 4; figure 1: CD/CD-ROM).

In regard to claim 9, Lee discloses that the second reproducer is a hard disk drive unit (column 3, line 60 thru column 4, line 9).

Claim 10 has limitations that are similar to those of claim 5 (as best interpreted by the Examiner in light of the 112 rejections above); thus, it is rejected on the same basis. Furthermore, Lee also discloses "a controller which judges, prior to the first reproducer's reproduction of the program information, that the program information is copied onto the second recording medium" (see Figure 3, step 170: outputting data to a speaker, i.e., the claimed "first reproducer's reproduction of the program information". Since S170 is the last step in this Figure, it is understood that the judging function of the controller occurs "prior" to this step).

In regard to claim 11, Lee discloses an information reproducing apparatus (Figure 1), comprising: a first reproduction circuit (100) capable of reproducing data (MP3 Audio File) from a first recording medium (CD/CD-ROM); a second reproduction circuit (500) capable of reproducing data from a second recording medium (200); and a control circuit (200; see also

column 3, lines 24-25; and the inherency statements made above) that copies program information reproduced by the first reproduction circuit onto the second recording medium, and determines that the program information has been copied, and if the control circuit determines that the program information has been copied, the control circuit controls the first reproduction circuit to not reproduce the program information from the first recording medium, and the control circuit controls the second reproduction circuit to reproduce the program information from the second recording medium.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 6, 12 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Hira (US 5,392,264).

For a description of Lee, see the rejection above. Furthermore, in regard to claim 13, Lee discloses an information reproducing apparatus (Figure 1), comprising: a first reproduction circuit (100) capable of reproducing data (MP3 Audio File) from a first recording medium (CD/CD-ROM); a second reproduction circuit (500) capable of reproducing data from a second recording medium (200); and a control circuit that copies program information reproduced by the first reproduction circuit onto the second recording medium, and determines that the program information has been copied, and if the control circuit determines that the program information has been copied, the control circuit controls the first reproduction circuit to not reproduce the

program information from the first recording medium, and the control circuit controls the second reproduction circuit to reproduce the program information from the second recording medium (inherent: note that the program information is either copied onto the second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. The file type detector 100 involves receiving source data and detecting the type of data, i.e., the "program information is reproduced" in order to detect the type of data. See column 3, lines 38-43). Furthermore, Lee inherently discloses: in claims 12 & 13, that the control circuit controls the second reproduction circuit to delete the program information from the second recording medium; and in claim 6, that the driver deletes the program information from the second recording medium. Note that the phrase "temporarily stores the files" recited in column 3, line 25 suggests that the files are going to be erased eventually, i.e., the files are not stored permanently in the second recording medium. However, in regard to claims 6, 12 & 13, Lee is silent regarding deleting the program information from the second recording medium when/if the first recording medium is removed from the first reproducer.

Hira discloses clearing data contents from a memory when an operation indication of discharging a recording medium is detected or when a tray is opened and closed (see column 12, lines 9-13), i.e., the claimed "deletes the program information from the second recording medium when the first recording medium is removed from the first reproducer". It would have been obvious to one of ordinary skill in the art at the time of invention to have deleted the program information of Lee when the first recording medium is removed as suggested by Hira,

the motivation being to prevent memory overflow and/or to provide sufficient memory space for subsequent operations, which is a well-known purpose of clearing contents of memory.

*Allowable Subject Matter*

12. Claims 1-3 are allowed over the prior art of record. See the Office Action mailed October 12, 2004 for a statement of reasons for the indication of allowable subject matter.

*Response to Amendment*

13. The amendment filed February 14, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: see item 5 above.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Response to Arguments*

14. Applicant's arguments filed February 14, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues on page 9, paragraph 2 that "the determination made in Lee is distinguishable from the judgment step recited in claim 4. Whereas Lee determines the type of information on the disk, claim 4 determines whether the information has been copied onto the second recording medium". The Examiner disagrees. As noted in the Office Action mailed October 12, 2004, this feature is inherently taught by Lee. Column 3, lines 38-43 of Lee describe a file type detector 100 that involves receiving source data and detecting the type of data, i.e., the "program information is reproduced" in order to detect the type of data. Note that in Lee, the program information is either copied onto the

second recording medium, i.e., when an MP3 audio file is detected; or not copied onto the second recording medium, i.e., when an ordinary audio CD file is detected. Therefore, Lee, although indirectly, nevertheless determines whether information has been copied onto the second recording medium.

b. The Applicant argues on page 9, paragraph 2 that "these are clearly different determinations made for different purposes, and that the determination made in Lee is irrelevant to the method recited in claim 4". The Examiner disagrees. The teachings of Lee and the recitation in claim 4 are made for the same purpose of determining whether to reproduce data from a second recording medium (temporary storage), or to reproduce data directly from the disk.

c. The Applicant argues on page 9, paragraph 2 that "the judgment step recited in claim 4 cannot be inherent to Lee unless it is a strictly necessary part of the invention. Since Lee does not disclose reuse of information recorded on the second storage medium, there is no need for Lee to determine that such information has been copied". The Examiner disagrees. Lee describes in column 3, lines 38-43 a file type detector 100 that involves receiving source data and detecting the type of data, which, as described above, determines whether information has been copied onto the second recording medium. This clearly shows that the file type detector of Lee is a necessary part of Lee's invention.

*Conclusion*

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin
Art Unit 2652

BRIAN E. MILLER
PRIMARY EXAMINER